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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,013	06/28/2005	Eric Henderson	016348-9048-US00	9052

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EXAMINER
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LAM, ANN Y

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/541,013

**Applicant(s)**

HENDERSON ET AL.

**Examiner**

Ann Y. Lam

**Art Unit**

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

***Lack of Unity***

This application contains the following inventions or groups of inventions which are not linked as to form a single inventive concept under PCT Rule 13.1.

Group I, claims 1-13, drawn to an apparatus for analyzing a sample.

Group II, claims 14-17 and 27, drawn to a method of detecting a molecular interaction event.

Group III, claims 18-21, drawn to a method of analyzing one or more analytes in a cell.

Group IV, claim 22, drawn to a method of retrieving at least one analyte.

Group V, claims 23-26, drawn to a method of delivering at least one substance to a cell.

The inventions listed as Groups I and (II-V) do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack a common special technical feature over the prior art for the following reasons:

The inventions are linked together to form a single inventive concept by the apparatus of Group I. However, the apparatus of group I is known in the art, as shown by Matson et al., 5,981,185, (see col. 3, lines 39-41, and col. 6, lines 16-19, disclosing an array of probes on a dipstick solid support.)

Therefore the inventions I and (II-V) do not form a general inventive concept as they do not share a common special technical feature over the prior art.

Therefore, the technical feature linking the inventions of groups I and (II-V) does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of Group I is considered to be an apparatus comprising a probe having a plurality of domains disposed thereon, the domains forming an array.

The special technical feature of Group II is considered to be a method of detecting a molecular interaction event comprising contacting a sample with a probe having a plurality of domains disposed in an array, incubating, and washing unbound molecules from the domains and detecting the molecular interaction event.

The special technical feature of Group III is considered to be a method of analyzing one or more analytes in a cells comprising disrupting a cell with a microdisrupter disposed on a probe, wherein the probe has a plurality of domains disposed thereon, the domains forming a nanoarray, passing the nanoarray through the membrane of the cell and detecting binding of analytes to the nanoarray.

The special technical feature of Group IV is a method of retrieving an analyte from a sample comprising contacting the sample with a probe having a plurality of domains forming array, and retrieving the analyte from the domains.

The special technical feature of Group V is a method of delivering at least one substance to a cell comprising reversibly attaching a substance to a probe having a plurality of domains disposed thereon, wherein the domains form an array; passing the

probe through the membrane of the cell, and releasing at least one substance into the intracellular space.

Accordingly, Groups I-V are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

The inventions listed as Groups II-V do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack a common special technical feature over the prior art for the following reasons:

The inventions listed as Groups II-V do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking the groups II-V appears to be that they all relate to a probe having a plurality of domains in an array.

Matson et al., 5,981,185, however discloses an array of probes on a dipstick solid support (see col. 3, lines 39-41, and col. 6, lines 16-19).

Therefore, the technical feature linking the inventions of groups II-V does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of Group II is considered to be a method of detecting a molecular interaction event comprising contacting a sample with a probe having a plurality of domains disposed in an array, incubating, and washing unbound molecules from the domains and detecting the molecular interaction event.

The special technical feature of Group III is considered to be a method of analyzing one or more analytes in a cells comprising disrupting a cell with a microdisrupter disposed on a probe, wherein the probe has a plurality of domains disposed thereon, the domains forming a nanoarray, passing the nanoarray through the membrane of the cell and detecting binding of analytes to the nanoarray.

The special technical feature of Group IV is a method of retrieving an analyte from a sample comprising contacting the sample with a probe having a plurality of domains forming array, and retrieving the analyte from the domains.

The special technical feature of Group V is a method of delivering at least one substance to a cell comprising reversibly attaching a substance to a probe having a plurality of domains disposed thereon, wherein the domains form an array; passing the probe through the membrane of the cell, and releasing at least one substance into the intracellular space.

Accordingly, Groups II-V are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on Mon.-Fri. 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1641

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Ann Lam 12/12/06